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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/709,783

05/27/2004

Mohammed Moin Hussaini

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EXAMINER

MEHTA, PARIKHA SOLANKI

ART UNIT

PAPER NUMBER

3737

NOTIFICATION DATE

DELIVERY MODE

03/05/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptopatentmail@cantorcolburn.com

Office Action Summary	Application No. 10/709,783	Applicant(s) HUSSAINI ET AL.	
	Examiner PARIKHA S. MEHTA	Art Unit 3737	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-10,12,14,16,17,19,20 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10,12,14,16,17,19, 20 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 2, 4-10, 12, 14, 16, 17, 19, 20 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Susil (WO 02/22015), hereinafter Susil ('015), previously made of record, in view of Wang et al (US Patent No. 5,657,429), hereinafter Wang ('429), further in view of Onik (US Patent No. 4,583,538), hereinafter Onik ('538), previously of record.

Regarding claims 1, 2, 4 and 24, Susil ('015) teaches a method and system for guiding an end effector to a target position, wherein the end effector is spatially associated with a robot coordinate system (Abstract, p. 7 lines 24-27), including steps for generating a plurality of CT images, indicating a skin entry position, indicating a target position, determining a trajectory path, registering the robot and image coordinate spaces using a fiducial component associated with the end effector, and moving the end effector along the trajectory path (Figs. 1 & 2, p. 4 lines 14-19 & 24-25, p. 5 lines 7-8 & 21-25, p. 6 lines 17-18 & 21-25, p. 9 lines 1-6, p. 14 lines 6-19). Since the end effector of Susil ('015) is moved by a computerized means, it is considered to move at a predetermined speed as claimed in the instant application. Furthermore, Susil ('015) teaches that the method and system may be used for a variety of biopsy and/or therapeutic procedures (p. 14 line 24 – p. 15 line 5). The system provided by Susil ('015) additionally includes computers for generating, displaying and registering the image data (Figs. 1 & 2).

Art Unit: 3737

Susil ('015) does not expressly teach computation of first and second trajectories based on the image space coordinate system and robot coordinate system, respectively, wherein the trajectories are translated between the two spaces via a transformation matrix. Susil ('015) does generally teach means and steps for transforming information from the image space to the robot space, which constitutes computation of two trajectories, one in each of the spaces, as claimed (p. 10 lines 1-17). Using matrices for coordinate space transformation is very well known in the art of robotics, as exemplified by Wang (col. 6 lines 7-43). It would have been obvious to one of ordinary skill in the art at the time of invention to use the matrix transformation steps and means of Wang ('429) with the method and system of Susil ('015) in order to establish a functional relationship between the image space and robot space, as such a modification would require nothing more than the mere combination of known prior art elements to yield predictable results, which has previously been held as unpatentable (see for precedent *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385).

Susil ('015) additionally lacks means and steps for monitoring a respiratory state of the subject over time. In the same field of endeavor of CT-guided biopsy, Onik ('538) teaches means and steps for monitoring the patient's respiratory phase for ensuring that the biopsy steps are performed during the same phase of respiration (col. 2 lines 20-22, col. 6 lines 43-46). Onik ('538) states that the movement of the instrument should be gated based upon the patient's respiratory phase via a gating device, which is considered to be an implicit teaching of means and steps for stopping movement of the instrument when the patient is not in the predetermined respiratory phase (col. 9 lines 15-27). Onik ('538) additionally teaches respiratory phase monitoring is effective to enhance precision of surgical localization in the abdominal cavity while the patient is experiencing respiratory motion (col. 1 line 65 – col. 2 line 8). The means and steps for determining whether or not the patient is in a particular respiratory phase as taught by Onik ('538) constitutes determining whether the patient's monitored respiratory state is between a predetermined amplitude range having upper and lower thresholds, and it also constitutes the generation of a signal indicative of the respiratory state over time as is presently claimed.

It would have been obvious to one of ordinary skill in the art at the time of invention to modify Susil ('015), as modified by Wang ('429) to further include the respiratory monitoring means and steps of Onik ('538), in view of the teachings of Onik ('538).

Regarding claims 6-8, Susil ('015), Wang ('429) and Onik ('538) substantially teach all features of the claimed system as discussed for the method of claims 1, 2, 4 and 24. The respiratory gating device of Onik ('538) (col. 9 lines 17-18) constitutes a respiratory monitoring device configured to generate a first signal that is indicative of respiratory states of the person over time, wherein the degree of respiration

Art Unit: 3737

as taught by Onik ('538) constitutes the claimed "position of the chest". Neither Susil ('015), Wang ('429) nor Onik ('538) expressly teach a third computer that determines whether the amplitude of the respiratory signal is within the predetermined amplitude range. Onik ('538) does teach generally of respiratory gating, which is known in the art to require computerized execution. Although Onik ('538) does not teach of a separate ("third") computer to perform such gating, Applicant has not disclosed that the use of a separate computer solves a particular problem or presents a patentable advantage over the prior art. Furthermore, it has previously been held that the separation or duplication of known parts is not a patentable advance over the prior art (*In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961); *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960)). As such, even if it were assumed that Onik ('538) did not implicitly teach the third computer for gating, such computer would be obvious over the prior art, as it would require nothing more than the separation or duplication of the computer expressly taught by Onik ('538).

Regarding claims 9-10, Susil ('015) provides a driver configured to linearly move the end effector, a positioning device for positioning the end effector, and an insertion device for orienting the end effector along the trajectory path (p. 9 lines 23-29).

Regarding claim 12, state of the art CT systems are known to include computerized means of positioning the patient to obtain a series of axial image slices during scanning.

Regarding claim 14, since the end effector of Susil ('015) is moved by computerized means, it is considered to move at a predetermined speed as claimed in the instant application.

Regarding claims 16, 17, 19 and 20, the computerized system of Susil ('015), Wang ('429) and Onik ('538) must inherently include code for executing the steps as previously discussed for claims 1, 6 and 15, as it would not otherwise be operable.

Regarding claims 22 and 23, Onik ('538) teaches generating a gating signal in response to the patient's respiratory phase and subsequently moving the end effector in response to the gating signal (col. 2 lines 20-22). Moving the end effector inherently involves a plurality of steps, including at least the steps of transmission of a signal from the gating device to the robot, and subsequent movement of the end effector in response to such signal, in order for the reference invention to be operable.

Response to Arguments

Art Unit: 3737

4. Applicant's arguments filed 9 December 2008 have been fully considered but they are not persuasive. Applicant alleges that the guiding of an instrument when specific respiratory conditions are met does not constitute the claimed moving of the end effector when the signal is within the predetermined range and stopping movement when the signal is not within the range (Remarks p. 2). Examiner maintains that the respiratory state, or "degree of respiration" of Onik fairly constitutes an amplitude range having upper and lower thresholds (col. 9 lines 20-25), and the teaching of "mak[ing] equivalent the degree of respiration at said steps of [imaging] and said step of guiding said instrument" (col. 9 lines 25-27) fairly constitutes a teaching of only moving the end effector when the respiratory signal (degree of respiration) is within such an amplitude range. Furthermore, respiratory gating, as is clearly taught by Onik, is by definition the execution of an action when a patient's respiratory state is within a predetermined range having an upper and lower threshold.

As Applicant's arguments are wholly unpersuasive for at least the foregoing reasons, the pending claims remain unpatentable over the prior art of record as set forth herein.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PARIKHA S. MEHTA whose telephone number is (571)272-3248. The examiner can normally be reached on M-F, 8 - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571.272.4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3737

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BRIAN CASLER/
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3737

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Examiner, Art Unit 3737